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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/742,698	12/19/2003	John Richard Segerstrom	JRS 302	4517
23581 7590 03/14/2008 KOLISCH HARTWELL, P.C. 520 SW YAMHILL STREET, Suite 200 PORTLAND, OR 97204				
EXAMINER				
FLEISCHER, MARK A				
ART UNIT		PAPER NUMBER		
4143				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/742,698

**Applicant(s)**

SEGERSTROM, JOHN RICHARD

**Examiner**

MARK A. FLEISCHER

**Art Unit**

4143

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

1. This office action is in response to Applicant's communication filed on 19 December 2003.
2. Claims 1 and 2 are pending in the application

### ***Acknowledgements***

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### ***Double Patenting***

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
5. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
6. Claims 1 and 2 of this application conflict with claims 1 and 2, respectively of Application No. 10/763571. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Macrae (US 2003/0093310).

**Claims 1 and 2:**

Macrae, as shown, describes and/or discloses the following limitations.

- *A strategic business method for financial institutions, comprising:*
  - *establishing a strategic metric* (Macrae, in at least [0025] states: "These deliverables include [...] Strategic Goals & Metrics [...]" (emphasis added) where the 'deliverables' corresponds to *establishing* and the emphasized text correspondence is self-evident.);
  - *setting measurable goals using the established strategic metric* (Macrae in at least [0028] states: "Missions [ ] assign specific responsibilities to company organizations for attaining measurable goals and for implementing the Corporate strategy as defined in the Business and Technology Strategic Plan [ ]." (emphasis added) where *setting measurable goals* corresponds to the 'measurable goals...implementing the ... strategy as defined in...' and the 'plan' and the term 'defined in' corresponds to *using the established strategic metric*.);
  - *communicating the goals effectively* (Macrae in at least [0080] states: "This phase may also involve [...] communicating changes to the organization; and rewarding successes and lessons learned." (emphasis added) where

- 'communicating changes' corresponds to *communicating the goals* and 'rewarding successes' is an example of *do so effectively*.); and
- *measuring and reporting progress in reaching the goals* (Macrae in at least [0072] states: "[M]etrics are collected on data required [...] to measure goal achievement and progress [...]" (emphasis added) where the emphasized text corresponds to *measuring ...progress in reaching the goals*. Macrae in [0063] specifically refers to "status reporting" pertaining to the metrics.)

With respect to Claim 2, Examiner notes that the distinguishing term *structure* is inherent in the invention. Moreover, Macrae, in at least [0019] specifically describes and/or discloses the following: "The Business Management Process (BMP) provides a structured, process-centric approach to defining: the business direction of a company; specific, measurable goals for the company; a high-level plan to achieve those goals; and the necessary infrastructure required to support the high-level plan." (emphasis added) where the 'structured, process-centric' corresponds to the *structure for establishing*...and the remaining elements of the limitations.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are:
- US Patent Application No. 2004/0015375,
  - US Patent Application No 2003/0088493 and
  - US Patent 5875431 A.

Art Unit: 4143

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Dr. **Mark A. Fleischer** whose telephone number is **571.270.3925**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** whose telephone number is **571.272.6710** may be contacted.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building

401 Dulany Street

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Mark A. Fleischer, Ph.D.

/Mark A Fleischer/ Examiner, Art Unit 4143

27 February 2008

/JAMES A REAGAN/Supervisory Patent Examiner, Art Unit 4143